



**APPELLANT'S REPLY TO EXAMINER'S
ANSWER
37 CFR §1.192**

Docket No. M1025/7004

Applicant: Giorgio Trani and Marion Sterner
Serial No: 09/678,008
Filed: October 3, 2000
For: CONTAINER WITH INHERENTLY STABLE BASE MADE OF FLEXIBLE
MATERIAL AND METHOD FOR MANUFACTURING IT
Examiner: Sameh H. Tawfik
Art Unit: 3721


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TECHNOLOGY CENTER R3700


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Assistant Commissioner for Patents
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This Reply Brief is in furtherance of the Notice of Appeal being filed concurrently herewith.

This Reply Brief is transmitted in triplicate.

I. REPLY ARGUMENT (37 C.F.R. 1.192(c)(8))

Contrary to the Examiner's assertion, the cited Schneider reference does not teach the method claim elements of forming, folding, heat sealing and/or bonding of triangles and/or wings on the sides of a container laterally to a longitudinal seal or seam of the container.

Claims 5 and 13 are the independent claims remaining in this application and on appeal. Both of these independent claims call for the method steps of forming, folding, bonding and/or heat-sealing of triangles and/or wings on the sides of a container laterally to a longitudinal seal that runs along the length of the container.

The examiner's Answer asserts that it is the examiner's belief that the Schneider reference (U.K. 1,115,636) discloses these steps based on the showing of an extension 22 from the bottom surface of the package shown in Figure 1 of the cited Schneider reference.

Applicants respectfully disagree.

The Schneider reference does not disclose or suggest the forming of a triangle or wing, or the folding, bonding or heat-sealing of a wing lateral to the seam 20 shown in Schneider's Figure 1. The bottom platform 22 shown in Schneider's Figure 1 is not anywhere discussed in Schneider's written description as being folded or bonded to the side walls, 12, 14 of the package. To the contrary, it is suggested by Schneider's figures that this bottom formed platform 22 "protrudes" and "remains" as an extension of a flat base for Schneider's Fig. 1 package. This is consistently shown in all of Schneider's Figures that are pertinent to the Figure 1 embodiment, e.g. Figs. 3, 4, 5, 6, 7, 8, 9. No method step is discussed in Schneider's specification that would suggest that the "flat" base having the flat lateral extensions 22 should be folded up onto the sides 12, 14 of the package lateral to the longitudinal seam 20. The opposite seems to be suggested by the Schneider figures and written description, i.e. that the lateral extension should "remain" coplanar and flat together with the flat bottom surface of the package.

The method steps of independent claims 5 and 13 are clearly not anticipated by the Schneider reference. They are not inherently disclosed. They are not expressly disclosed. It is improper to read these steps into a prior art reference.

In order for a Section 102(b) anticipation to exist, the prior art reference must disclose all of the elements of the allegedly anticipated claims. Juicy Whip, Inc. v. Orange Bang, Inc., 63 U.S.P.Q.2d 1251, 292 F.3d 728 (Fed. Cir. 2002); Application of Marshall, 198 U.S.P.Q. 344, 578 F.2d 301 (C.C.P.A. 1978).

The claims in issue in this application are method claims. The standard for finding a Section 102(b) anticipation of a method claim is no less stringent than for an apparatus claim. In the Juicy Whip case for example, the Federal Circuit said:

When the asserted basis of invalidity is [Section 102(b) anticipation], the party with the burden of proof must show that "the subject of the barring activity met each of the limitations of the claim, and thus was an embodiment of the claimed invention." *Scaltech Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1383, 51 USPQ2d 1055, 1058 (Fed.Cir.1999).

"Claim 6 is directed to a "method for inducing sales of a beverage" comprising the step of "positioning a transparent display bowl relative to the dispenser outlet to create the visual impression that said bowl is the reservoir and principal source from which a serving of the beverage is dispensed." '405 patent, col. 12, ll. 53-56. Claim 9 requires that the dispenser be "positioned relative to said outlet to create the visual impression that said container is the reservoir and principal source of said dispensed beverage issuing from said outlet." '405 patent, col. 13, ll. 10- 13. While the record contains testimony from several witnesses which, if believed by the jury, indicates that some of

the claim limitations were found in the 1983 and 1988 dispensers, the record is devoid of evidence showing that the above limitations were found in either dispenser.

Similarly, in another method claim case, In Re Marshall, 198 U.S.P.Q. 344, 578 F.2d 301 (C.C.P.A. 1978), the appeals court (C.C.P.A.) stated:

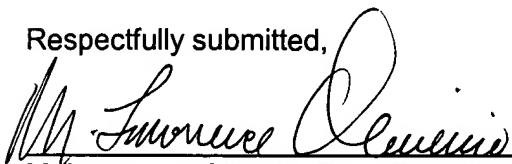
Rejections under 35 U.S.C. s 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. In re Arkley, 455 F.2d 586, 587, 59 CCPA 804, 807, 172 USPQ 524, 526 (1972). In other words, to constitute an **anticipation, all material elements** recited in a claim must be found in one unit of prior art. Soundsciber Corp. v. United States, 360 F.2d 954, 960, 175 Ct.Cl. 644, 148 USPQ 298, 301 (1966).

Applying this rule of law to the present case, we must reverse the board's rejection of claims 1-4 under 35 U.S.C. s 102 since the primary reference, the PDR, does not disclose every material element of the claimed subject matter. These **claims** are directed to a weight control **process**. Applicant uses an effective amount of the anesthetic, oxethazaine, to inhibit release of the pancreatic secretory hormones, secretin and pancreozymin, in order to control weight. The PDR, however, teaches using drugs containing the anesthetic oxethazaine to inhibit release of the acid-stimulating hormone, gastrin, in order to treat esophagitis, gastritis, peptic ulcer and irritable colon syndrome. Nothing in the PDR remotely suggests taking oxethazaine to lose weight

CONCLUSION

For the reasons stated above, it is respectfully requested that the examiner's rejection of claims 5-13 of the present application be reversed and that the present application be allowed for issuance.

Respectfully submitted,



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IX APPENDIX OF CLAIMS (37 C.F.R. 1.192(c)(9))

The text of the claims involved in the appeal are:

5. A method for manufacturing an inherently stable container made of flexible material, comprising the following steps:

a) folding a continuous film of flexible material of appropriate width, to obtain a pouch having a longitudinal heat-seal and evenly spaced transverse heat-seals, followed by cropping the folded film in a direction transverse to the longitudinal heat seal;

b) heat-sealing in sides of the pouch, at a region of the transverse heat-seals, forming two triangles having wings laterally disposed relative to the longitudinal heat-seal;

c) punch opening said pouch, and optionally filling the pouch with a product; d) folding and bonding the wings laterally relative to the longitudinal heat-seal and, after filling the pouch, simultaneously with the bonding of the wings, heat-sealing an upper open mouth of the pouch.

6. The method of claim 5, wherein in the first step the film is folded so as to form the pouch, which is closed longitudinally by heat-sealing overlapping flaps of said film, said heat-sealing being preferably located at a center of one of two flat faces of said pouch.

7. The method of claim 5, wherein a longitudinal dimension of the pouch is determined by way of transverse heat-seals.

8. The method of claim 6, wherein the heat-sealing of the triangles comprises heat-sealing of two overlapping sheets of flexible material that constitute said pouch so as to form at the base, said two triangles with vertex sedging inside said pouch.

9. The method of claim 5, further comprising forming ribs during the step for forming the heat-sealed triangles, said ribs being adapted to facilitate, by guided deformation, opening of the pouch at filling.

12 10. The method of claim 9, wherein during filling of the pouch with product a substantially flat
13 base forms, while said wings formed due to the heat-sealed triangles protrude laterally beyond
14 said base.

15 11. The method of claim 10, wherein following said filling step said wings are folded toward
16 the container and are retained thereon.

17 12. The method of claim 5, comprising insertion of the heat-sealed triangles inside the
18 container by way of pushing means which push said triangles from the outside inward.

19 13. A method for manufacturing an inherently stable container made of flexible material,
20 comprising the steps of:

21 a) folding a continuous film of flexible material of appropriate width, to obtain a
22 pouch having a longitudinal heat-seal and evenly spaced transverse heat-seals, followed by
23 cropping the folded film in a direction transverse of the longitudinal heat-seal ;

24 b) heat-sealing two triangles having wings into sides of the pouch lateral to the
25 longitudinal heat-seal, each of the triangles having a base which coincides with one edge of the
26 pouch and a vertex which wedges inwards said pouch lateral to the longitudinal heat-seal punch
27 opening said pouch, and optionally filling the pouch with a product folding and bonding the
28 wings onto the triangles.